

REMARKS

By this Amendment, Applicants amend claims 1, 6, 7, 9, 11, and 17-19 to more appropriately define the present invention, rewrite claim 13 in independent form, and cancel claims 12 and 14-16 without prejudice or disclaimer of the subject matter thereof. Claims 1-11, 13, and 17-19 are now pending in this application.

In the Office Action,¹ the Examiner rejected claims 1, 2, 7-12, 14-17, and 19 under 35 U.S.C. § 102(e) as anticipated by Yagi et al. (U.S. Patent No. 6,404,980); rejected claims 3-6 and 18 under 35 U.S.C. § 103(a) as obvious over Yagi in view of Ueda et al. (U.S. Patent No. 6,289,102); and objected to claim 13 as dependent upon a rejected base claim, but allowable if rewritten in independent form to include all of the limitations its base claim and any intervening claims.

Applicants appreciate the Examiner's indication of allowable subject matter in this case. Applicants have rewritten claim 13 in independent form, and accordingly, request that the Examiner allow claim 13 in the next Office communication.

Applicants respectfully traverse the Examiner's rejection of claims 1, 2, 7-12, 14-17, and 19 under 35 U.S.C. § 102(e) as anticipated by Yagi, and note that the Examiner's rejection with respect to canceled claims 12 and 14-16 is moot. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1 recites a combination including “management information,” the management information being “configured to include one or more regions of user defined program chains for storing program chain information defined by a user, the program chains indicating a sequence of information items including the audio information.” Yagi does not teach at least these features of claim 1.

By contrast, in the Yagi system, when a user instructs a change of audio streams and when an application flag of an audio stream indicates “dubbing audio data” or “customized audio data,” a control unit instructs a MPEG decoder to change the audio stream. See col. 24, lines 62-66. Furthermore, because each of the VOBs recorded onto an optical disc have a predetermined amount of space that can store data for dubbing, the audio data may be dubbed in VOBs without re-encoding or re-locating the VOBs. See col. 25, lines 1-6. Yagi, however, does not disclose Applicants’ claimed “management information,” which is “configured to include one or more regions of user defined program chains for storing program chain information defined by a user, the program chains indicating a sequence of information items including the audio information,” as recited in claim 1. Instead, in the Yagi system, dubbing is performed only by replacing audio data in the packs with other data since a predetermined amount of space is allocated for an audio stream. See col. 25, lines 7-11. The Yagi system’s use of a predetermined amount of space for an audio stream, however, does not

constitute Applicants' claimed "management information." Since Yagi does not teach all of the features of claim 1, Yagi does not anticipate the claim. Accordingly, Applicants request that the Examiner withdraw the rejection and allow claim 1.

Independent claims 7, 9, 11, 17, and 19 while of a different scope from claim 1 and each other, include recitations of a scope similar to allowable claim 1. Claims 7, 9, 11, 17, and 19 are therefore allowable at least due to their dependence and Applicants request the Examiner to withdraw the rejection and allow claims 7, 9, 11, 17, and 19.

Dependent claims 2, 8, and 10 depend from allowable claims 1, 7, and 9, respectively, and accordingly, are allowable at least due to their dependence. Applicants therefore request that the Examiner withdraw the rejection and allow claims 2, 8 and 10.

Applicants respectfully traverse the rejection of claims 3-6 and 18 under 35 U.S.C. § 103(a) as obvious over Yagi in view of Ueda because the Examiner has not established a *prima facie* case of obviousness. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements

must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claims 3-5 depend from allowable claim 1, which recites "management information," which is "configured to include one or more regions of user defined program chains for storing program chain information defined by a user, the program chains indicating a sequence of information items including the audio information." As discussed above, Yagi does not disclose at least these features.

While the Ueuda system unscrambles data based on information obtained by converting key information (See, for example, col. 3, lines 51-58), Ueuda does not make up for the above-noted shortcomings of Yagi. Accordingly, Yagi and Ueuda, whether taken alone or in combination, do not disclose or suggest "management information," which is "configured to include one or more regions of user defined program chains for storing program chain information defined by a user, the program chains indicating a sequence of information items including the audio information," as recited in claim 1, from which claims 3-5 depend. Accordingly, claims 3-5 are not obvious over Yagi in view of Ueueda and Applicants request that the Examiner withdraw the rejection and allow the claims.

Independent claims 6 and 18, while of a different scope from each other and claim 1, include recitations similar to that of allowable claim 1. For example, claim 6 recites, among other things, "management information ... configured to include one or more regions of user defined program chains for storing program chain information defined by a user, the program chains indicating a sequence of information items including the audio information." Moreover, claim 18 recites "management information

... configured to include one or more regions of user defined program chains for storing program chain information defined by a user, the program chains indicating a sequence of information items including the audio information, and wherein said data structure is configured to include management directories of the audio information and the image information.” As noted, Yagi and Ueuda fail to disclose or suggest at least these features. Accordingly, claims 6 and 18 are also allowable over Yagi in view of Ueueda at least for reasons discussed above in connection with claims 3-5.

Furthermore, in rejecting claims 3-6 and 18 under § 103(a), the Examiner has not provided a motivation for combining Yagi and Ueuda. For example, the Examiner alleges that one skilled in the art would incorporate features of dependent claims 4-5, which the Examiner alleges are taught by Ueuda, with teachings of Yagi “to control reproduction based on authentication w/ disk ID and also having protected scrambled content, preventing unauthorized use.” See Office Action, page 5. The Examiner also alleges with respect to dependent claim 6 that one skilled in the art would combine Yagi with Ueuda to provide “a non-encrypted header [that] informs the system of encryption or not associated with the audio data.” See Office Action, page 6. The Examiner has also applied the same rationale to reject claim 18 as used in rejecting claim 6. In these allegations, however, the Examiner has not cited any factual evidence that is either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, that would lead one of skilled in the art to combine the references in a manner resulting in the claimed invention. Accordingly, a *prima facie* case of obviousness has not been made and the Examiner should withdraw the rejection of claims 3-6 and 18 for at least this additional reason.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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